



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,179	03/12/2004	J. Dean Cole	31181.43	8156

27683 7590 09/08/2006

HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3733

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,179

Applicant(s)

COLE, J. DEAN

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 24-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 3, 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the invention of Group I (claims 1-2 and 4-23) in the reply filed on June 13, 2006 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP §818.03(a)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 19, 21-22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepper et al. (US 5,951,561) in view of Leu et al. (US 6,270,499).

Pepper et al. disclose a method for creating a portal into the canal of a bone including the steps of: (1) providing a protective sheath 22 having a tapered end; (2) guiding a cutting member through the sheath 22; and (3) insertion of an intramedullary nail (Figs. 1 and 2, col. 3, lines 66-67, col. 4, col. 5, lines 1-59, col. 7, lines 56-67 and col. 8, lines 1-25).

Pepper et al. disclose all elements of the claimed invention except for insertion of an intramedullary nail using supra patellar surgical access.

Leu et al. teach insertion of an intramedullary nail or fixation member in the intramedullary canal of a tibia wherein the intramedullary nail is anchored to the tibia by means of screws at non-perpendicular angles to one another and to the fixation member (Figs. 1 and 4, col. 3, lines 47-67 and col. 4, lines 1-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the Pepper et al. method to gain supra patellar

access to the intramedullary canal of a tibia for insertion of an intramedullary nail, as taught by Leu et al., for fracture fixation.

Claims 17-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepper et al. (US 5,951,561) and Leu et al. (US 6,270,499), in view of Lambrecht et al. (US 6,036,696) and Sullivan (US 6,189,788).

The combination of Pepper et al. and Leu et al. discloses all elements of the claimed invention except for providing a guide wire having a radiopaque marker.

It is very well known to position an intramedullary nail in a canal using a guide wire, as demonstrated by Lambrecht et al., for fluoroscopic imaging of nail insertion (col. 1, lines 54-67 and col. 2, lines 1-7).

It is also very well known to provide radiopaque sections on a guide wire to fluoroscopically monitor insertion of the guide wire, as demonstrated by Sullivan.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a guide wire having radiopaque sections to fluoroscopically monitor insertion of a nail into the prepared intramedullary canal of a tibia, as taught by Lambrecht et al. and Sullivan, in the method of Pepper et al. and Leu et al.

The method steps of claims 17-18 and 20 are rendered obvious by the above discussion.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

Art Unit: 3733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR


September 4, 2006